

REMARKS

Claims 187-201 and 217-231 are pending.

Preliminarily, the Specification has been objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Specifically, paragraphs 0041-0043, 0046 and 0047 are objected to. Applicants have amended paragraphs 0041-0043, 0046 and 0047 of the Specification to remove the reference to the hyperlink and Applicants have addressed the issues raised by the Notice of Non-Compliant Amendment through the presently submitted amendment. These amendments replace those submitted in the Response filed February 11, 2005, which were not entered due to non-compliance.

Applicants note with appreciation that the rejection of claims 188-189, 191-192 and 194 under 35 U.S.C. § 102(e) has been withdrawn, as it has not been repeated in the Office Action of 4 May 2005.

I. REJECTIONS UNDER 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a)

The Examiner has maintained the rejection of claims 187, 190, 193 and 195-201 under 35 U.S.C. § 102(e) as anticipated by Nidamarty *et al.* (US 2003/0206969). Office Action of 4 May 2005 at page 2. The Examiner has further maintained the rejection of claims 187-201 and 217-231 under 35 U.S.C. § 103(a) as being unpatentable over Nidamarty *et al.* (US 2003/0206969). Office Action of 4 May 2005 at page 3. The Declaration of John Giodano under 37 C.F.R. § 1.131, filed on 11 February 2005, is alleged to be ineffective to overcome the cited reference. Office Action of 4 May 2005 at page 3. Applicants respectfully traverse.

Without addressing the propriety of the Examiner's rejections, and specifically the Examiner's interpretation of what the cited reference teaches or suggests, Applicants respectfully maintain that the present rejections should be withdrawn because the Nidamarty patent application publication is not prior art to the Applicants' invention. The Nidamarty patent application publication was based on an application provisionally filed on 2 May 2002 and published on 6 November 2003. The Declaration Of John A. Giordano under 37 C.F.R. § 1.131 ("the Giordano Declaration") and its associated evidence establish that the claimed invention was reduced to practice before 2 May 2002, the provisional filing date of the Nidamarty patent application.

The Examiner asserts that the declaration under 37 C.F.R. § 1.131 is inappropriate under the present circumstances because the reference is allegedly claiming the same patentable invention as the Applicants' invention. Further, the Examiner asserts that the reference can only be overcome by establishing priority of invention through interference procedures. Applicants respectfully disagree. The Nidamarty patent application does not claim the same patentable invention as the present application, and additionally, the present application recites claims that are not anticipated by, or obvious in view of, the Nidamarty patent application.

The present application does not claim "the same patentable invention," as defined in 37 C.F.R. § 1.601(N):

Invention "A" is the same patentable invention as an invention "B" when invention "A" is the same as (35 U.S.C. § 102) or is obvious (35 U.S.C. § 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". Invention "A" is a separate patentable invention with respect to invention "B" when invention "A" is new (35 U.S.C. 102) and non-obvious (35 U.S.C. § 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A".

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent claims 187 and 217 of the present application each recite the element that the composition is "free of any other added minerals and any other added vitamins." The Nidamarty patent does not claim a composition that is "free of any other added minerals and any other added vitamins" and moreover that element is not taught by Nidamarty. Therefore the inventions of claims 187, 190, 193 and 195-201 of the present application are not the same as and hence new (35 U.S.C. § 102) in view of the claimed inventions in Nidamarty and the present rejection should be reconsidered and withdrawn.

Further, the Applicants' claims are not obvious in light of that which is disclosed and presently claimed in Nidamarty. To maintain a proper rejection under 35 U.S.C. § 103, the USPTO must meet four conditions to establish a *prima facie* case of obviousness. First, the USPTO must show that the prior art suggested to those of ordinary skill in the art that they should make the claimed composition or device or carry out the claimed process. Second, the USPTO must show that the prior art would have provided one of ordinary skill in the art with a reasonable expectation of success. Third, the prior art must teach or suggest all the claim limitations. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). Fourth, if an

obviousness rejection is based on some combination of prior art references, the USPTO must show the suggestion, teaching, or motivation to combine the prior art references. *In re Dembicza*k, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Neither the Nidamarty claims nor the Nidamarty specification teach or suggest a composition “free of any other added minerals and any other added vitamins.” In fact, Nidamarty teaches away from such a composition by suggesting a composition to be used as a multivitamin/multimineral dietary supplement “by inclusion of additional vitamins and minerals.” Nidamarty, paragraph [0062]. Therefore the inventions of claims 187-201 and 217-231 of the present application are non-obvious (35 U.S.C. § 103) in view of the claimed inventions in Nidamarty. Therefore, the Applicants’ inventions are separate patentable inventions with respect to claimed inventions of Nidamarty

The claims of the present application are not anticipated and are non-obvious in light of Nidamarty for reasons similar those for determining that the two claimed inventions are separate patentable inventions. Independent claims 187 and 217 of the present application both recite that the composition is “free of any other added minerals and any other added vitamins.” The Nidamarty patent does not teach or claim a composition that is “free of any other added minerals and any other added vitamins.” Therefore the claims 187, 190, 193 and 195-201 of the present application are not anticipated by Nidamarty. Further, Nidamarty does not teach or suggest a composition “free of any other added minerals and any other added vitamins.” In fact, Nidamarty teaches away from such a composition by suggesting a composition to be used as a multivitamin/multimineral dietary supplement “by inclusion of additional vitamins and minerals.” Nidamarty, paragraph [0062]. Therefore the claims 187-201 and 217-231 of the present application are not obvious in view of the Nidamarty.

Finally, Examiner has suggested that the reference can only be overcome by establishing priority of invention through interference proceedings. Office Action of 4 May 2005 at page 3. Applicants respectfully disagree. The requirements of an interference between applications is defined in 37 C.F.R. § 1.603:

Before an interference is declared between two or more applications, the examiner must be of the opinion that there is interfering subject matter claimed in the applications which is patentable to each applicant subject to a judgment in the interference. The interfering subject matter shall be defined by one or more counts. Each application must contain, or be amended to contain, at least one claim that is patentable over the prior art and corresponds to each count. All claims in the applications which define the same patentable invention as a count shall be designated to correspond to the count.

Further, one of the applications should be in condition for allowance. MPEP § 2303. Finally, interferences will not be declared between pending applications if there is a difference of more than 3 months between effective filing dates of the applications in the case of inventions of simple character, and a difference of not more than 6 months in the effective filing dates of applications in other cases. *Id.* In the present case, neither the present application nor the Nidamarty application have any claim that is deemed patentable over the prior art by an examiner. The cited claims 35, 36 and 38 of the Nidamarty application are currently rejected under 35 U.S.C. § 103, as determined by an Office Action mailed May 20, 2005 in the Nidamarty application. Further, neither patent application has been deemed to be in condition for allowance by the USPTO. Finally, the apparent effective filing date of the Nidamarty application is May 2, 2002, over 7 months before the effective filing date of the present application of December 10, 2002. It is therefore impossible for the Applicants to declare an interference between the present application and Nidamarty application at this time.

Applicants submit that the Giordano Declaration under 37 C.F.R. § 1.131 is effective against the Nidamarty patent application, and that the Nidamarty patent application publication is not §102(e) prior art to the Applicants' invention. Further, the Applicants submit that even without the Giordano Declaration, the Nidamarty reference does not anticipate or make obvious the claims of the Applicants' invention. Finally, Applicants submit that it is impossible for them to resolve this issue at this time by declaring interference between the present application and Nidamarty. Accordingly, Applicants respectfully request reconsideration and withdrawal of the present rejections.

II. REJECTION UNDER NONSTATUTORY DOUBLE PATENTING

The Examiner has maintained the provisional rejection of claims 187 and 217 and newly rejected claims 188-201 and 218-231 under the doctrine of obviousness-type double patenting as being unpatentable over claims 45, 46, 287 and 288 of copending Application No. 10/315,159, now claims 1-4 of issued U.S. Patent No. 6,814,983. Office Action of 4 May 2005 at page 5. Additionally, claims 187-201 and 217-231 remain provisionally rejected under the doctrine of obviousness-type double patenting as being unpatentable over claims 45, 46, 287 and 288 of copending Application No. 10/315,159, now claims 1-4 of issued U.S. Patent No. 6,814,983, in view of Manning et al. (U.S. Patent 6,569,445) or Nidamarty et al. (US 2003/0206969). *Id.* at page 7.

The Examiner has instructed that a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) may be used to overcome an actual or provisional rejection based on non-statutory double patenting ground. Without addressing the propriety of the Examiner's rejection, and specifically the Examiner's interpretation of what the cited references teach or suggest, Applicants respectfully and properly defer addressing the present rejection until there is otherwise allowable subject matter in the present application. Only then is it proper to assess the propriety of the Examiner's rejection in view of the potentially allowable claims. Accordingly, Applicants respectfully request reconsideration and withdrawal of the present rejections or that the rejections be held in abeyance until claims are otherwise allowable in the present application.

CONCLUSION

Applicants have properly and fully addressed each of the Examiner's grounds for rejection. Applicants submit that the present application is now in condition for allowance. If the Examiner has any questions or believes further discussion will aid examination and advance prosecution of the application, a telephone call to the undersigned is invited.

If there are any additional fees due in connection with the filing of this amendment, please charge the fees to undersigned's Deposit Account No. 50-1067. If any extensions or fees are not accounted for, such extension is requested and the associated fee should be charged to our deposit account.

Respectfully submitted,

4 August 2005



Don J. Peltz
Reg. No. 33,754

Preston Gates Ellis & Rouvelas Meeds, L.L.P.
1735 New York Avenue NW, Suite 500
Washington, DC 20006
Telephone: (202) 628-1700
Facsimile: (202) 331-1024